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No. 310

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IN THE

Supreme Court of the United States

OCTOBER TERM, 1943

SINCLAIR REFINING COMPANY,

Petitioner,

vs.

CONWAY P. COE, COMMISSIONER OF PATENTS,

Respondent.

**PETITION FOR WRIT OF CERTIORARI TO THE
UNITED STATES COURT OF APPEALS FOR
THE DISTRICT OF COLUMBIA AND
BRIEF IN SUPPORT THEREOF**

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of Counsel.



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SINCLAIR REFINING COMPANY,

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v.

CONWAY P. COE, COMMISSIONER OF PATENTS,

Respondent.

PETITION FOR WRIT OF CERTIORARI

TO THE HONORABLE, THE CHIEF JUSTICE AND THE ASSOCIATED JUSTICES OF THE SUPREME COURT OF THE UNITED STATES:

Your petitioner, Sinclair Refining Company, prays that a writ of certiorari issue to review the decree of the United States Court of Appeals for the District of Columbia entered herein on May 1, 1944 (R. 499).

A certified transcript of the record in the case, including the proceedings in the Court of Appeals, is furnished herewith in compliance with Rule 38 of this Court.

Summary Statement of the Matter Involved

This is a suit in equity brought by petitioner against the Commissioner of Patents in the United States District Court for the District of Columbia pursuant to the provisions of Section 4915, R. S. (35 U. S. C., Sec. 63) as

amended by Act of March 2, 1927, for an order authorizing and directing the Commissioner of Patents to issue to petitioner a patent for improvements in Oil Cracking Processes, as defined in certain claims in applications for letters patent duly filed in the United States Patent Office and assigned to petitioner. The claims in question were rejected by the Patent Office on definitely stated grounds and the grant of a patent containing such claims was refused.

The above mentioned statute gives the applicant whose patent has been so refused a right of action against the Commissioner of Patents. In such action the Commissioner of Patents, through the Solicitor for the Patent Office, sets up in its Answer to the complaint his reasons for refusing the grant of the patent, and the issues so defined are tried before the Court.

In the case at bar the answer of the Patent Office (R. 8) asserted that the disputed claims were not patentable to petitioner because of certain interference proceedings in the Patent Office decided, in part, adversely to petitioner. The District Court for the District of Columbia concluded that the Commissioner's grounds for refusing the patent sought by petitioner were sound and dismissed the complaint, and, in accordance with the practice of the District Court the Judgment of Dismissal was accompanied by Findings of Fact and Conclusions of Law (R. 10-12) wherein the issues presented by the pleadings were specifically ruled upon.

The claims were not refused by the Patent Office on the ground that they were unpatentable over the prior art. The answer of the Commissioner of Patents in this action contained no such allegation and no finding of fact to that effect was included in the Findings of the District Judge in support of the Judgment of Dismissal.

On appeal to the Court of Appeals for the District of Columbia the Judgment of Dismissal was affirmed, *but no*

ruling was made by the Court of Appeals on the issues presented for review by the Findings of the Lower Court, the sole ground of affirmance being the conclusion reached by the Court on its own motion that the claims were unpatentable over the prior art (R. 498).

The interferences referred to in the Answer of the Commissioner of Patents were declared before the *ex parte* prosecution of the application of petitioner's assignor Herthel was concluded, and, in accordance with the usual practice the *ex parte* prosecution of the application was suspended pending the outcome of the interference. The interferences were decided partly in favor of this applicant and partly in favor of the opposing party, Jenkins, whose application as originally filed appears in the record, pages 79 to 100, inclusive. After the conclusion of the interferences the Herthel application was remanded to the Primary Examiner for continuance of the *ex parte* prosecution. During the course of the *ex parte* prosecution applicant presented certain additional claims, including *inter alia*, the claims here in dispute. Some of the additional claims were allowed but the claims in dispute were rejected on the ground that they related to subject matter disclosed in the application of the adverse party in the interference proceeding.

It is the well established and universally applied rule of the Patent Office in the *ex parte* prosecution of an application after the termination of an interference, to refuse any claim which could have been based on the application of the other interfering party as originally filed and which could therefore have been included in the interference. Your petitioner contended that the claims here in dispute had no foundation in the application of the other party to the interference, but the Patent Office held otherwise and rejected the claims on that ground.

No question of the patentability of the claims over the prior art was raised by the Patent Office. The disputed

claims are obviously more limited than the issues of the interference and the patentability of the interference issues over the prior art was fully considered, both before and during the interference proceedings. Petitioner's position is that the disputed claims are not only *more* limited than the issues of the interference proceedings, but are so limited as to *exclude altogether* the disclosure of the Jenkins application. The Patent Office does not deny that the disputed claims are more limited than the issues of the interference which have been found patentable over the prior art, but *does contend* that the claims are *not sufficiently limited to fully exclude the Jenkins application*, and that petitioner is therefore barred by the interference proceedings from making such claims.

As stated above, this was the sole ground of rejection asserted by the Patent Office and is the sole ground for the dismissal of petitioner's complaint recited in the Findings of the lower Court. The Court of Appeals for the District of Columbia apparently gave no consideration whatsoever to the relation of the disputed claims to the Jenkins application, but has affirmed the judgment of the lower Court on an issue projected into the case of its own motion.

The Questions Presented

(1) May the Court of Appeals for the District of Columbia, in an appeal from an adverse decision in an action against the Commissioner of Patents under Section 4915 R. S. dispose of the appeal by holding the claims in dispute unpatentable over the prior art, when that question was not in issue and was not decided by the Court below?

(2) Does the public interest in the scope and validity of patents justify the Court of Appeals in ruling of its own motion on the patentability of the disputed claims

over the prior art in an action where the Commissioner of Patents *is the sole respondent* and does not raise the issue?

Reasons Why the Writ Should be Granted

(1) The action of the Court of Appeals for the District of Columbia in deciding this case *solely* on grounds not decided by the lower Court is contrary to established procedure and such action has been repeatedly condemned by this Court.

The grant of this petition will give to petitioner the review of the decision of the lower Court to which it is entitled, and which has been denied by the action of the Court of Appeals of the District of Columbia.

LeTulle v. Scofield, Collector of Internal Revenue,
308 U. S. 415, 416:

We took this case because the petition for certiorari alleged that the Circuit Court of Appeals had based its decision on a point not presented or argued by the litigants, which the petitioner had never had an opportunity to meet by the production of evidence.

See also:

Luther and Moore Lumber Co. v. Knight, 217 U. S.
257, 265;

General Utilities Co. v. Helvering, 296 U. S. 200;

Hornet v. Helvering, 312 U. S. 552.

(2) The consideration of the question of patentability over the prior art of its own motion by an appellate court on an appeal where such a question is not presented is *justified only in exceptional cases to protect the public interest*. In a case where the Commissioner of Patents is the sole defendant, the public interest requires no further protection. If the decision of the Court of Appeals of the District of Columbia be allowed to stand, every

appellant, whatever the issue in the Patent Office—whether sufficiency of disclosure, new matter, public use, or what not—will have to present in its appeal a complete record on the question of patentability over the prior art even though that question be already decided in its favor in the Patent Office.

WHEREFORE it is respectfully submitted that this petition for a writ of certiorari to the Court of Appeals for the District of Columbia should be granted.

W. B. MORTON
Counsel for Petitioner

RAYMOND F. ADAMS
LOUIS D. FORWARD
Of Counsel

Dated: New York, N. Y.,
July 26, 1944





BRIEF IN SUPPORT OF PETITION FOR WRIT OF CERTIORARI

Opinions of the Courts Below

No opinion was handed down by the District Court for the District of Columbia. Its findings of fact and conclusions of law appear in the record (pp. 10-12). The opinion of the Court of Appeals for the District of Columbia appears at page 498 of the record and is reported in 138 F. (2nd) 673.

Jurisdiction

The jurisdiction of this Court is invoked under Section 240 (a) of the Judicial Code as amended by the Act of Feb. 13, 1925, c. 229 (28 U. S. Code, Sec. 347). The decree of the U. S. Court of Appeals for the District of Columbia (R. 499) which petitioner seeks to have reviewed was entered May 1, 1944.

Statement of the Case

The essential facts of the case are stated in the accompanying petition for a writ of certiorari.

Specification of Errors

The errors which petitioner will urge if the writ of certiorari is issued, are that the Court of Appeals for the District of Columbia erred:

1. In holding that the disputed claims were unpatentable over the prior art.

2. In not holding that the disputed claims are patentable to petitioner as supplemental to the interference counts awarded petitioner and are not directed to subject-matter disclosed in the Jenkins application as filed.

Summary of Argument

The points of argument will follow the reasons relied upon for allowance of the writ of certiorari.

ARGUMENT

POINT I

The consideration of the patentability of the disputed claims over the prior art by the U. S. Court of Appeals for the District of Columbia was contrary to the established rule of this Court that issues not presented and considered in the lower court are not subject to review in an appellate court.

The patentability of the disputed claims over the prior art was not put in issue by the pleadings, was not considered by the lower court, and no decision with respect thereto is embraced in its Findings of Fact or Conclusions of Law.

There is no dispute between the parties as to the patentability of the claims over the prior art. That question was raised in the *ex parte* prosecution of the interfering applications before the declaration of the interferences. (See for example the actions of the Primary Examiners, R. 101, 102, 110, 141-5, 171, 210, 213, etc.)

Claims of broader scope than those here in dispute were allowed over the prior art and made the issues of the interferences. The patentability of those broader claims over the prior art was again raised by motion to dissolve the interferences (R. 384, *et seq.*), which motion was denied

(R. 432) and the interferences carried through to final decision on priority of invention with respect to the stated issues, which were awarded in part to petitioner's assignor, Herthel, and in part to his adversary, Jenkins. A patent (No. 2,617,211) was subsequently issued to Jenkins on the application in interference (R. 485).

The Patent Office declares an interference when one of the interfering applications is otherwise ready for allowance—in this case the Jenkins application. The *ex parte* prosecution of the application of petitioner's assignor Herthel was not concluded, at the time the interference was declared, and in accordance with the usual practice, the *ex parte* prosecution was suspended pending the conclusion of the interference proceedings. Upon the resumption of the *ex parte* prosecution of the Herthel application the disputed claims were presented and their allowance urged on the ground that they were specific to procedures disclosed in the Herthel application and not in the Jenkins application. The Patent Office conceded that these claims were more limited than those which had been awarded to Jenkins. The Examiner's statement on appeal asserted:

“(1) Claims 14 and 15 have never previously been before the Board.

(2) Claims 11, 12 and 13,* which the Board passed on in the decision containing the ruling to which applicant adverts, did not contain the limitation here in controversy” (R. 241).

The Patent Office held the subject matter of the disputed claim was disclosed in the Jenkins application and refused the claims on the sole ground that their allowance to Herthel was barred by the interference proceedings and

* Claims 11, 12 and 13 were the claims which were awarded to Jenkins by the Court of Customs and Patent Appeals in the interference controversy. The Patent Office Board of Appeals had awarded priority to Herthel with respect to all controverted subject-matter.

the grant to Jenkins of a patent on the issues awarded to him. *The refusal of the claims on this ground was the sole issue raised by the pleadings and decided by the lower Court.*

An interference, like any other judicial proceeding, is conclusive, not only of the issues presented, but also of those issues which might have been presented—so the question to be decided in this action is whether or not the subject-matter of the disputed claims is disclosed in the Jenkins application as originally filed. This is the question which was decided adversely to petitioner by the lower Court and made the basis for its Findings of Fact and Conclusions of Law. The correctness of that ruling was the sole issue raised by the appeal, and the Appellate Court should have found on that issue and should not have found against petitioner on an issue not presented by the pleadings and with respect to which the parties themselves were not in dispute.

Bradstreet v. Potter, 16 Pet. 317; 41 U. S. 201;
*Old Jordan Mining and Milling Co. v. Société
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*Gila Valley, Globe & Northern Railway Company
 v. Hall*, 232 U. S. 94;
Duignan v. United States et al., 274 U. S. 195;
Husty v. United States, 282 U. S. 694.

POINT II

There is no public interest involved which justifies the Court of Appeals of the District of Columbia in reviewing on its own motion the patentability of the disputed claims over the prior art in a case of this sort where the issues are defined by the answer of the Commissioner of Patents and no issue of patentability over the prior art is presented.

The Court of Appeals for the District of Columbia doubtless regards *Radtke Patents Corp. v. Coe, et al.*, 122 F.

(2nd) 937 as a precedent for its action here. In that case, however, the Commissioner of Patents was not, as here, the sole respondent. The Commissioner of Patents was in fact merely a nominal respondent. That action, while brought under the provisions of Sec. 4915 R.S.* 35 U. S. C., Sec. 63, was not a case "where a patent on application was refused by the Board of Appeals" wherein the Commissioner of Patents was the sole respondent but was brought by an applicant who was "dissatisfied with the decision of the Board of Interference Examiners" and the other parties to the interference were the real respondents. The only action by the Commissioner of Patents

*§ 63. BILL IN EQUITY TO OBTAIN PATENT

Whenever a patent on application is refused by the Board of Appeals or whenever any applicant is dissatisfied with the decision of the board of interference examiners, the applicant, unless appeal has been taken to the United States Court of Customs and Patent Appeals, and such appeal is pending or has been decided, in which case no action may be brought under this section, may have remedy by bill in equity, if filed within six months after such refusal or decision; and the court having cognizance thereof, on notice to adverse parties and other due proceedings had, may adjudge that such applicant is entitled according to law, to receive a patent for his invention, as specified in his claim or for any part thereof, as the facts in the case may appear. And such adjudication, if it be in favor of the right of the applicant, shall authorize the commissioner to issue such patent on the applicant filing in the Patent Office a copy of the adjudication and otherwise complying with the requirements of law. In all cases where there is no opposing party a copy of the bill shall be served on the commissioner; and all the expenses of the proceedings shall be paid by the applicant, whether the final decision is in his favor or not. In all suits brought hereunder where there are adverse parties the record in the Patent Office shall be admitted in whole or in part, on motion of either party, subject to such terms and conditions as to costs, expenses, and the further cross-examination of the witnesses as the court may impose, without prejudice, however, to the right of the parties to take further testimony. The testimony and exhibits, or parts thereof, of the record in the Patent Office when admitted shall have the same force and effect as if originally taken and produced in the suit. R. S. § 4915; February 9, 1893, c. 74, § 9, 27 Stat. 436; March 2, 1927, c. 273, § 11, 44 Stat. 1336; March 2, 1929, c. 488, § 2(b), 45 Stat. 1476; August 5, 1939, c. 451, § 4, 53 Stat. 1212.

in that case seems to have been a motion that the appeal be dismissed as to him.

The question directly at issue in the *Radtke* case was the question of priority among the interferants all of whom were claiming to be the first and original inventors of the invention in dispute. Also in that case a brief was filed by *amicus curiae* asserting that the claims were unpatentable because of new prior art discovered since the original allowance of the disputed claims. This *amicus curiae* was a member of the public directly seeking the protection of the Court in the public interest.

There have been other cases where appellate courts have, in the public interest, ruled on the validity of the patent, where that question was not at issue. For example, *Standard Water Systems Co. et al. v. Griscom Russell Co.*, 278 Fed. 703.

In that case, which was an infringement suit, the defendant was estopped because of certain confidential relations with plaintiff, from contesting the validity of the patent, but the Court of Appeals, acting in the public interest, held the patent invalid, notwithstanding the fact that validity was not in issue because of the estoppel.

Standard Water Systems Co. et al. v. Griscom-Russell Co., 278 Fed. 703, 705:

"It is true that the defendant Row, who asserted invention and received the patent, is estopped from denying invention; but he is not estopped from showing to what extent his alleged invention is limited by the prior art. This question, however, seems to be immaterial in this case. The public is interested in every adjudication with respect to the validity of a patent, and it is the duty of courts having jurisdiction of patent causes to have regard, at all times, of the rights of the public, so that such rights may be rather enlarged than diminished by judicial determination."

In all such cases of which we are aware, there has been evidence before the Court of invalidity of the disputed claims over the prior art, but for some exceptional reason the question of patentability has not been in dispute and consequently, but for the Court's action, there would be, to the detriment of the public, an apparent affirmance of validity without any trial of that issue. In the case at bar the patentability of the disputed claims to the petitioner is the direct issue. The Commissioner of Patents, the party directly charged with the grant or refusal of patents, is the sole party respondent. The Commissioner himself, by his Answer, defined the issues which were tried in the Court below and he did not include lack of patentability over the prior art as one of those issues.

There is nothing exceptional in the case at bar. The circumstances presented are those which arise at the conclusion of practically every Patent Office interference.

At least one of the applications in interference is usually remanded for further *ex parte* prosecution. The applicants naturally and properly endeavor to secure such claims as they can on such unique features of their own processes as are not disclosed by the other party. The Patent Office may not agree with the applicant that the claims relate to the unique features of their own processes, and not to the common subject matter, thereby creating issues such as presented here. In this quite usual situation the patent Examiner can certainly be relied upon to reject the claims if an applicant attempted to claim not only what was awarded his adversary, but also what was not patentable over the prior art.

There is certainly nothing in the record of the case at bar which justifies the Court of Appeals of the District of Columbia in substituting its judgment for the judgment of the officials of the Patent Office on the question of patentability of the disputed claims over the prior art. In fact, it is a well established rule that where, as here, the question of patentability has been raised on motion to dissolve, the presumption of validity is materially strengthened.

This Court, in *Hormel v. Helvering*, 312 U. S. 552 (*supra*, petition, p. 5), points out that it is only in the exceptional case where necessary to prevent miscarriage of justice that an Appellate Court is justified in deciding issues not passed upon below. There is certainly nothing in the case at bar to justify such action.

CONCLUSION

It is urged, therefore, that the petition for writ of certiorari be granted.

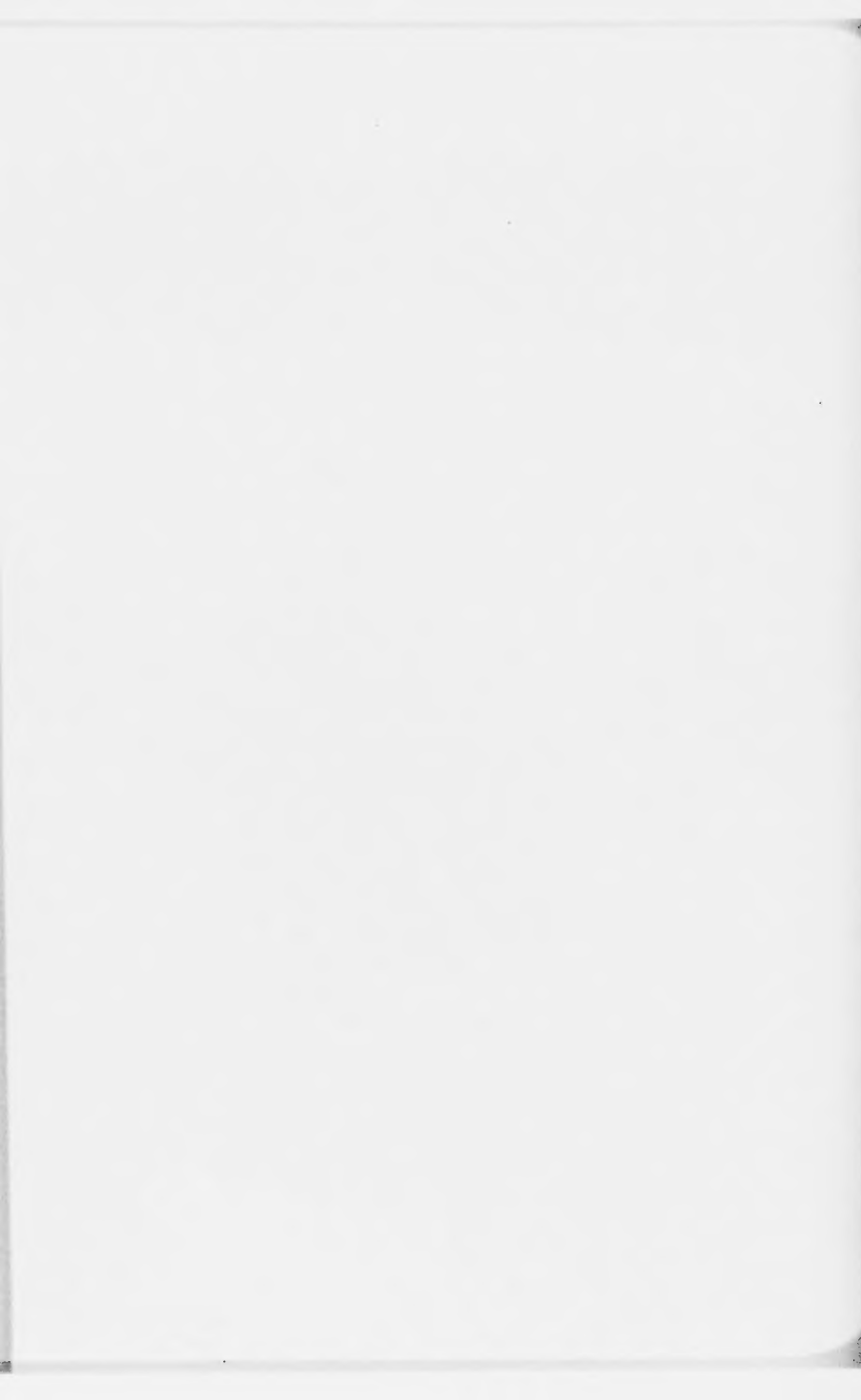
Respectfully submitted,

W. B. MORTON,
Counsel for Petitioner.

RAYMOND F. ADAMS,
LOUIS D. FORWARD,
Of Counsel.

Dated: New York, N. Y.
July 26, 1944.





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In the Supreme Court of the United States

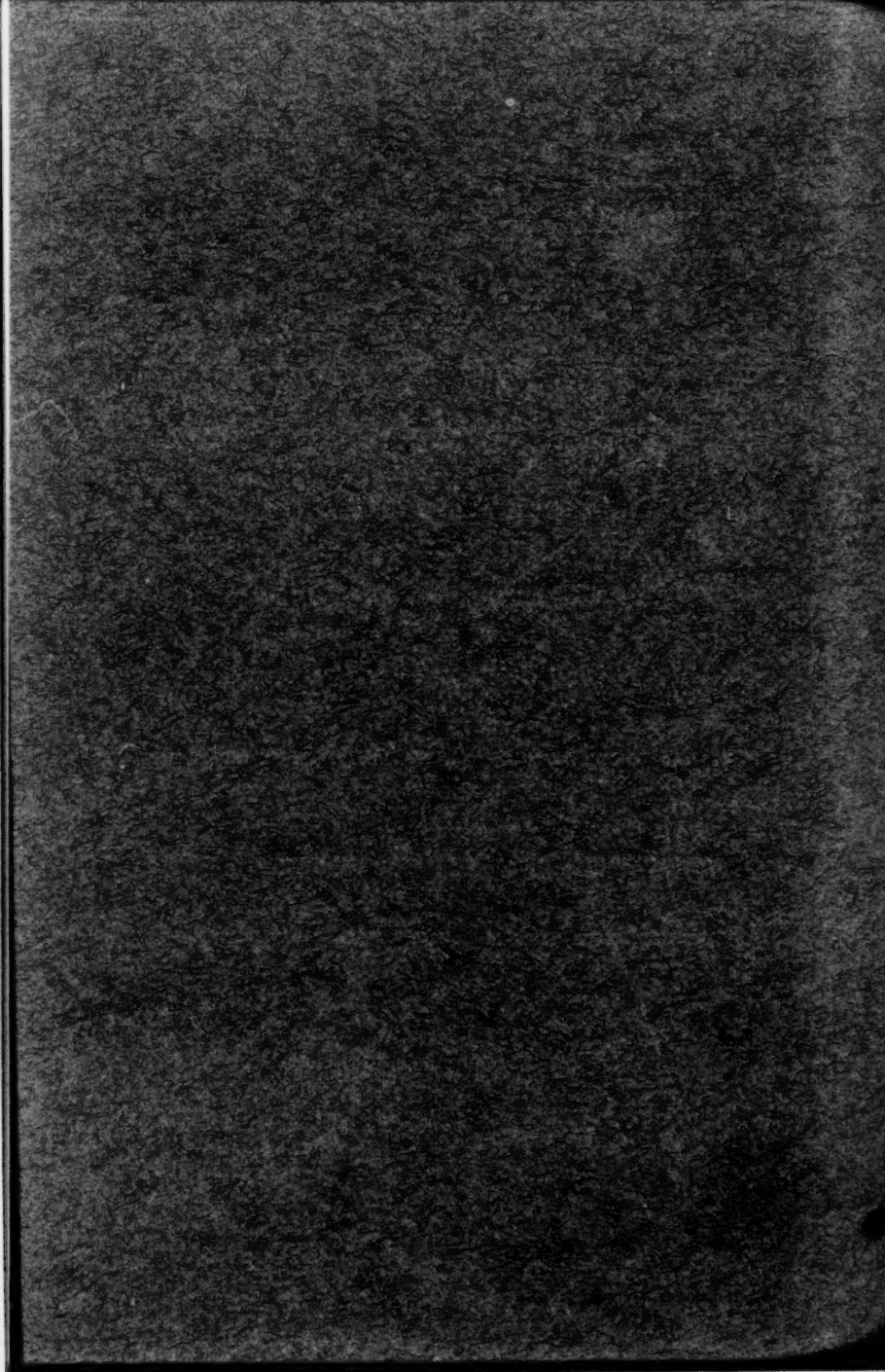
OCTOBER TERM, 1944

SINGULAR REFINING CO., PETITIONER

CONWAY P. COX, COMMISSIONER OF PATENTS

ON PETITION FOR A WRIT OF HABEAS CORPUS TO THE UNITED
STATES COURT OF APPEALS FOR THE DISTRICT OF
COLUMBIA

WRIT FOR HABEAS CORPUS IN HABEAS CORPUS



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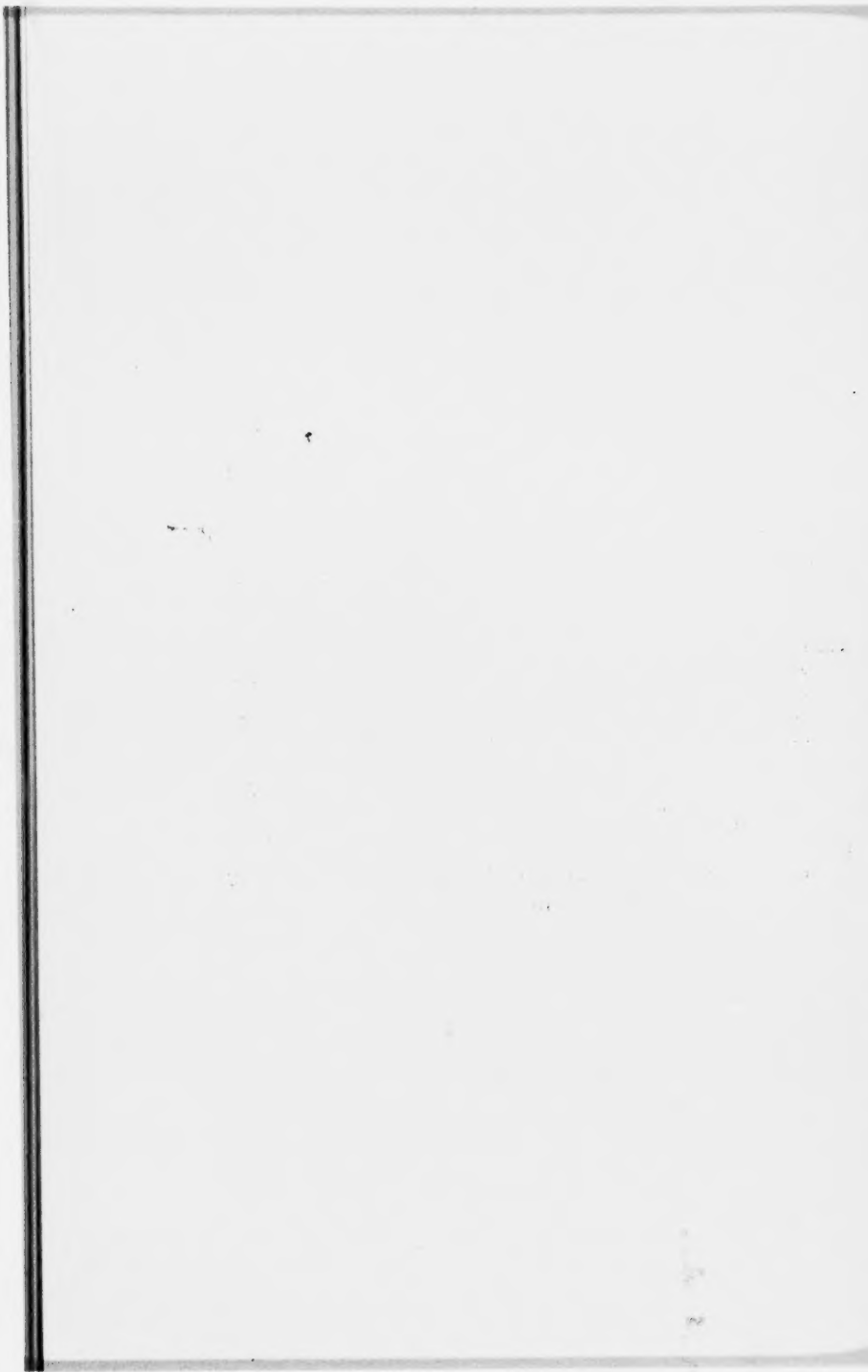
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In the Supreme Court of the United States

OCTOBER TERM, 1944

No. 310

SINCLAIR REFINING Co., PETITIONER

v.

CONWAY P. COE, COMMISSIONER OF PATENTS

*ON PETITION FOR A WRIT OF CERTIORARI TO THE UNITED
STATES COURT OF APPEALS FOR THE DISTRICT OF
COLUMBIA*

BRIEF FOR RESPONDENT IN OPPOSITION

OPINIONS BELOW

The findings of fact and conclusions of law of the District Court of the United States for the District of Columbia (R. 10-12) were entered without an opinion. The opinion of the United States Court of Appeals for the District of Columbia (R. 498) is reported in 142 F. (2d) 569.

JURISDICTION

The judgment of the Court of Appeals was entered May 1, 1944 (R. 499). The petition for a writ of certiorari was filed August 1, 1944. The

jurisdiction of this Court is invoked under Section 240 (a) of the Judicial Code as amended by the Act of February 13, 1925.

QUESTIONS PRESENTED

1. Whether the court below, in affirming the judgment of the district court, did so on the ground that the patent claims in dispute lacked invention; and, if so,

2. Whether the court below was justified in determining that question where it had not been raised specifically by respondent and had not been passed upon by the district court.

STATUTE INVOLVED

Section 4915 of the Revised Statutes (35 U. S. C. 63) provides:

Whenever a patent on application is refused by the Board of Appeals or whenever any applicant is dissatisfied with the decision of the board of interference examiners, the applicant, unless appeal has been taken to the United States Court of Customs and Patent Appeals, and such appeal is pending or has been decided, in which case no action may be brought under this section, may have remedy by bill in equity, if filed within six months after such refusal or decision; and the court having cognizance thereof, on notice to adverse parties and other due proceedings had, may adjudge that such applicant is entitled, according to law, to receive a patent for his invention, as specified in his

claim or for any part thereof, as the facts in the case may appear. And such adjudication, if it be in favor of the right of the applicant, shall authorize the commissioner to issue such patent on the applicant filing in the Patent Office a copy of the adjudication and otherwise complying with the requirements of law. In all cases where there is no opposing party a copy of the bill shall be served on the commissioner; and all the expenses of the proceedings shall be paid by the applicant, whether the final decision is in his favor or not. In all suits brought hereunder where there are adverse parties the record in the Patent Office shall be admitted in whole or in part, on motion of either party, subject to such terms and conditions as to costs, expenses, and the further cross-examination of the witnesses as the court may impose, without prejudice, however, to the right of the parties to take further testimony. The testimony and exhibits, or parts thereof, of the record in the Patent Office when admitted shall have the same force and effect as if originally taken and produced in the suit.

STATEMENT

Petitioner brought suit in the District Court of the United States for the District of Columbia under the above statute seeking a decree authorizing the Commissioner of Patents to issue a patent containing certain claims of one of three pending

patent applications.¹ The Commissioner answered, averring that the claims in question were "unpatentable in view of the prior patent to Jenkins, 2,167,211, July 25, 1939, * * * in view of the proceedings in Interferences Nos. 60,087 and 60,089 * * * and for the reasons given in the statement of the Primary Examiner" (R. 8-9).

The claims relate to oil cracking,² and were parts of original applications filed by one Herthel, the assignor of petitioner. The claims became involved in a lengthy interference proceeding with an application of one Jenkins in the Patent Office, which was resolved by a decision of the Court of Customs and Patent Appeals adjudging Jenkins to be prior where the substances to be added to the oil were described broadly, and holding Herthel to be prior in so far as the use of fuller's earth as an absorbent

¹ Claims 14 and 15 of Application No. 167,716; or claims 1 and 2 of Application No. 376,530; or claims 1 and 2, or 3 and 4 of Application No. 394,491.

² The district court described these claims as disclosing "the idea of adding finely divided absorbent substance such as fuller's earth to the oil circulating through the heating tubes of an oil cracking still while maintaining the velocity of circulation sufficiently high to insure the continuance of the absorbent in intimate admixture with the oil during its passage through the heating element. The oil circulating through the heating tubes in contact with the heated tube walls accordingly is intimately admixed with finely divided absorbent which selectively absorbs the more objectionable constituents of the cracking reaction as they are formed and while they are therefore in their most active state. By this process the deposition of carbon on the heating surfaces of the oil cracking still is prevented or greatly reduced." (R. 10-11.)

material was specified (claims 5 and 6). *Jenkins Petroleum Process Co. v. Herthel*, 102 F. (2d) 965.

After the conclusion of the interference proceedings, a patent was granted to Jenkins. Petitioner, whose application was still pending, in addition to claims 5 and 6 specifying fuller's earth which had been allowed in the interference proceeding, also sought to have allowed the claims here involved. These were rejected by the Primary Examiner and by the Board of Appeals of the Patent Office on the ground that they fell within the subject matter of Jenkins' prior claims (R. 235-278).

The district court upheld this result. Holding that in the interference proceedings priority had been awarded to Jenkins on the counts which recited in broad terms the substance added to the oil, and to Herthel on the counts limited to fuller's earth as the added substance, the district court found that the subject matter of the claims involved in the present action was not limited to fuller's earth as the absorbent material and was disclosed in the original Jenkins' application. It concluded as a matter of law that the decision of the Court of Customs and Patent Appeals as to priority of invention was *res judicata*, and also that petitioner was not entitled to a patent containing any of the claims involved in this suit. (R. 11-12.) On appeal, the Court of Appeals affirmed in a *per curiam* opinion.

ARGUMENT

Petitioner contends that the court below, by holding the claims in suit unpatentable over the prior art, has erred in deciding the case on a ground neither presented to nor considered by the District Court, without the presence of any public interest which would justify a review of patentability on the court's own motion. We submit that this argument is unfounded.

1. Petitioner's contention is based on a misapprehension of the decision of the Court of Appeals. The Court of Appeals pretermitted the question whether the judgment of the Court of Customs and Patent Appeals was *res judicata* in view of the provisions of R. S. 4915. The decision holds that petitioner's claims were unpatentable because of the priority of the patent to Jenkins. These two issues were apparent throughout the litigation. In the district court the respondent's answer alleged that the petitioner's claims are "unpatentable in view of the prior patent to Jenkins" and "in view of the proceedings in Interferences Nos. * * *" (R. 8-9). The district court concluded as a matter of law both that the question of priority of invention was *res judicata* and that the petitioner was not entitled to a patent containing the disputed claims (R. 11-12). In the Court of Appeals the respondent contended both that the decision of the Court of Customs and Patent Appeals is a bar to the

present suit, and that in any event the claims asserted are readable upon the disclosures of Jenkins.

In the light of this history of the litigation there can be no real doubt that the opinion below, after reserving the question of estoppel by judgment, and stating "that the disputed claims were unpatentable over the prior art; hence they were properly rejected by the Patent Office and the district court," must have referred to the Jenkins patent as constituting the prior art.

Support for this construction of the opinion below is found in the court's citation of *Daniels v. Coe*, 116 F. (2d) 941, 945; *Abbott v. Coe*, 109 F. (2d) 449, 451-452; and *Morrison v. Coe*, 127 F. (2d) 737, 738. The exact pattern of the instant case is found in *Daniels v. Coe*, 116 F. (2d) 941, 945;³ and both that case and the other two cited

³ *Daniels v. Coe*, like the present case, involved an interference, the issuance of a patent to the successful party (Robie), and a subsequent attempt by the unsuccessful party to have a patent issued involving claims which either were or might have been decided in the interference proceeding. Following an adverse ruling by the Patent Office, the unsuccessful applicant commenced suit in the district court under R. S. 4915, and following an adverse ruling there, he appealed to the Court of Appeals for the District of Columbia. That court held certain of the claims unpatentable in the light of the patent to the successful interference claimant, and others barred by the decision in the interference proceedings, saying: "Upon this record we cannot say that the Patent Office and the District Court are clearly wrong in their determinations that claims 44, 46, 47, and 52 are unpatentable in the light of the Robie patent. In our view,

are based upon the rationale that the judgment below must be affirmed unless the Court of Appeals is prepared to say "that the Patent Office and the District Court were clearly wrong" (*Morrison v. Coe*, 127 F. (2d) 737, 738), and that "disagreement is not sufficient for reversal" (*Abbott v. Coe*, 109 F. (2d) 449, 451). Had the court below intended to hold that the claims were precluded by prior art other than Jenkins' application, it would in all likelihood have cited its recent prior opinion in *Radtke Patents Corp. v. Coe*, 122 F. (2d) 937, 940, a decision directly in point on that question. We submit, accordingly, that the import of the *per curiam* opinion below was to affirm the decision of the district court on grounds relied upon both by it and by the Patent Office in rejecting the claims.

2. Even if it were assumed that the court below intended to rule that prior art other than Jenkins' precluded a patent to petitioner, no ground for review would exist. The issue whether, assuming petitioner's claims were not readable on the Jenkins application, they constitute a patentable advance over that application, was presented to the court below. Respondent's brief stated (pp. 7-8):

Moreover, even assuming that Jenkins does not disclose the rapid circulation set forth in the appellant's claims, such claims could not be allowed unless they define in-

plaintiff is estopped from making claims 49 and 50. The judgment of the District Court dismissing plaintiff's bill of complaint must be affirmed."

vention over the invention defined in the counts of interference No. 60,087 and over what Jenkins does disclose or, in other words, unless it required invention to speed up the circulation to the point where deposition of carbon and absorbent would be prevented. It seems obvious that no invention was involved in this idea. It is well known that a high velocity current will carry away particles which would be dropped by a slower one, and the flushing of conduits of various kinds by a high speed liquid current is conventional. Accordingly, if it were found that the absorbent and carbon were being deposited to an objectionable extent in the Jenkins system, it would be a natural and obvious thing to speed up the oil flow to take them out. This was conceded by plaintiff's witness Smith and it is also significant that, according to Smith's testimony the increasing of the current speed was the expedient actually tried when it was desired to lessen deposition in the tubes of the Jenkins still. [R. 34, 48-50.] Accordingly it is thought that the appellant should not be allowed claims which, if they distinguish over Jenkins and the issue of interference No. 60,087 at all, do so only on the basis of this obvious expedient.

Indeed, petitioner's brief recognized the issue, stating (p. 62):

Point III. The question presented by this point is whether the Herthel process as de-

fined in the claims now before the Court embodies a patentable advance over the procedure originally disclosed in the Jenkins application, the latter having admittedly been conceived and reduced to practice by Jenkins prior to Herthel's conception and reduction to practice, respectively, of the invention for which patent protection is now sought.

Thus there was before the court the contention, supported by evidence in the record, that the claims in suit did not involve invention in whatever respect they may not have been included in the Jenkins patent.

The contention which petitioner is here seeking to raise was advanced in the petitions for certiorari to review *Radtke Patents Corp. v. Coe, supra*, and certiorari was denied, 314 U. S. 695. See *Hill v. Wooster*, 132 U. S. 693, relied on in that case, holding that the issue of invention is always present in a proceeding under R. S. 4915, whether or not the parties raise it.

CONCLUSION

The decision of the court below is correct and there exists no conflict. We respectfully submit, therefore, that the petition for a writ of certiorari should be denied.

CHARLES FAHY,
Solicitor General.

FRANCIS M. SHEA,
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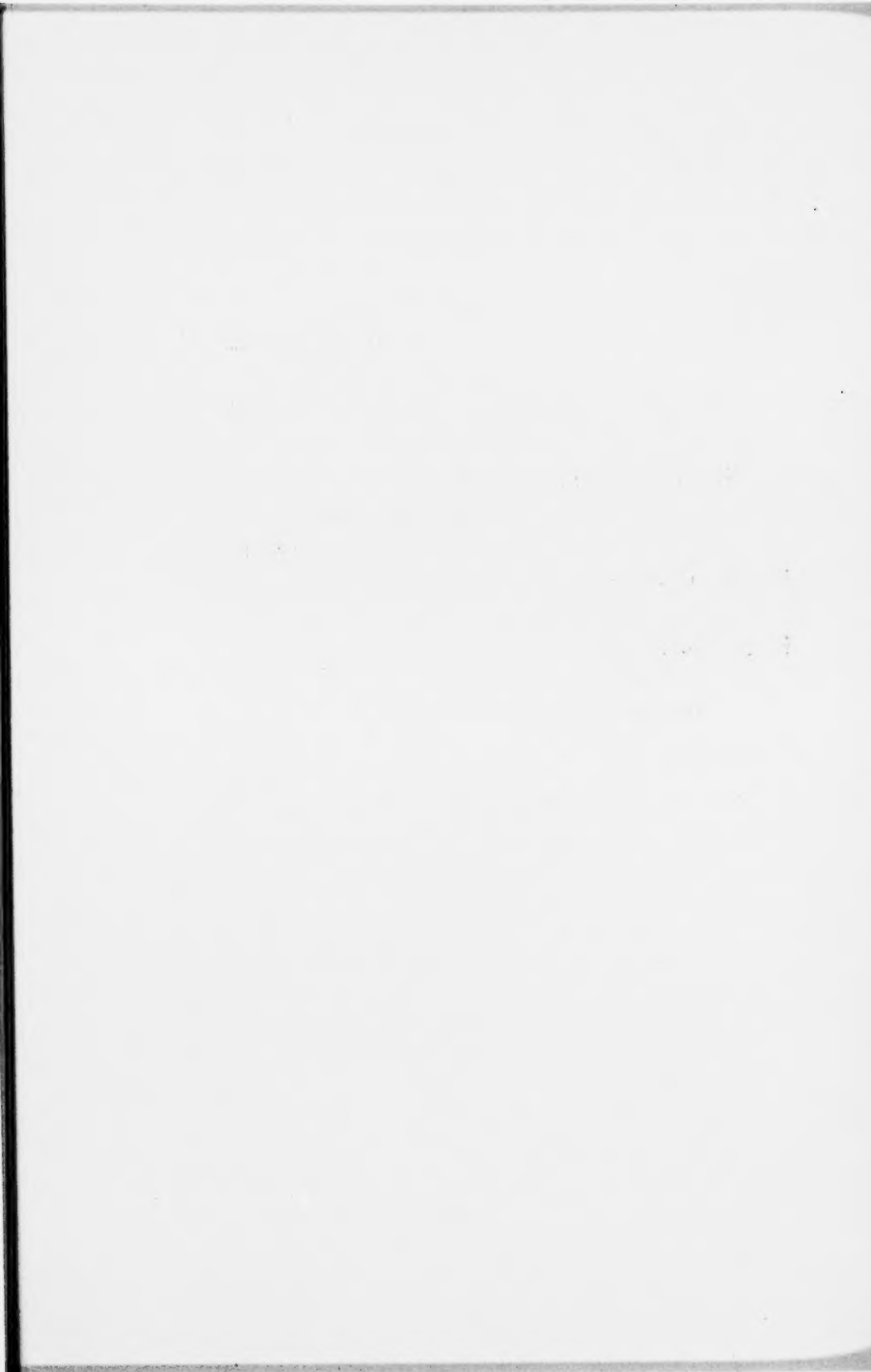
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SEPTEMBER 1944.



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FILED

SEP 22 1944

CHARLES CLIMBER DEXLEY
CLERK

IN THE
Supreme Court of the United States

OCTOBER TERM, 1944

No. 310

SINCLAIR REFINING Co.,
Petitioner,

v.

CONWAY P. COE, Commissioner of Patents,
Respondent.

ON PETITION FOR A WRIT OF CERTIORARI TO THE
UNITED STATES COURT OF APPEALS FOR
THE DISTRICT OF COLUMBIA

REPLY BRIEF FOR PETITIONER

W. B. MORTON,
LOUIS D. FORWARD,
Attorneys for Petitioner.

Sept. 19, 1944.



IN THE

Supreme Court of the United States

OCTOBER TERM, 1944

No. 310

SINCLAIR REFINING Co.,

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Respondent.

REPLY BRIEF FOR PETITIONER

The Respondent contends that Petitioner is in error in stating that the Court of Appeals for the District of Columbia decided this case on grounds not presented or considered in the lower Court. This contention is based on respondent's assumption that the Court of Appeals in "stating * * * 'that the disputed claims were unpatentable over the prior art' must have referred to the Jenkins patent as constituting the prior art" (Respondent's brief, p. 7). There is no basis for this assumption. The Jenkins patent is *not* prior art to the application here under consideration. The Jenkins patent issued on the application which was in interference with the Herthel application and contains as claims 23, 24 and 25 the counts of the interference issue which were awarded to Jenkins. The Herthel application contains as allowed claims numbered 5 and 6 (not here in dispute) the counts of the interference issues which were awarded to Herthel. This

award was made to Herthel because he established by evidence satisfactory to the Patent Office and the Court of Customs and Patent Appeals a date of invention prior to the Jenkins application date. As to counts which are now claims 23, 24 and 25 of the Jenkins patent, the Court of Customs and Patent Appeals awarded Jenkins a still earlier date. The testimony in the interference and the evidence submitted before the trial Court fully establish the practice by Herthel of the process defined by the claims here in dispute prior to the application date of the Jenkins patent, and it is not contended otherwise. It is inconceivable that the Court of Appeals could have meant the Jenkins *patent* when they said "the claims were unpatentable over the prior art".

The Jenkins patent is pertinent merely to the extent that the application of the patent as originally filed may disclose the subject-matter of the claims in issue. On the question of priority the decision of the Court of Customs and Patent Appeals is *res adjudicata* against both parties. After final decision in an interference, neither party can ask for a claim which could have been founded on the *original* application of the other party, for an interference decision, like any other judicial decision, determines not only the issues presented but the issues which could have been presented.

Hence, with respect to a claim presented subsequent to an interference, not only must the novelty and patentability over the prior art be considered, but it must also be determined that the claim is not directed to subject-matter disclosed in the original application of the other interfering party. As pointed out in our Brief in Support of the Petition for Certiorari (pp. 8, 9), the questions of novelty and patentability over the prior art of the Herthel and Jenkins inventions were fully considered by the Patent Office, and the claims here in dispute were rejected solely on the basis of the interference proceedings and the claims awarded to Jenkins as a result of that proceedings.

An action such as this under R. S. 4915 is a new action with the Commissioner of Patents as the sole defendant. Like any other defendant in an original action, he may set up any matters of defense which he believes to be sound. The solicitor for the Patent Office could have set up in his answer any prior art that he believed to be anticipatory and thus present that issue for trial in these proceedings, notwithstanding it had been decided favorably to applicant by the patent Examiner. The solicitor for the Patent Office did not do so and consequently Petitioner submitted no testimony whatsoever with regard to the novelty, etc. of the new claims.

The Court of Appeals of the District of Columbia understood fully that the issue presented here by the pleadings and decided by the District Court was limited to the patentability of the claims to Herthel in view of the interference with Jenkins. It was for that reason that the Court of Appeals of the District of Columbia in its opinion raised the question of whether "this proceeding was properly brought under 4915 R. S." The Court expressed the view at the argument that this *might* be a question between Herthel and Jenkins which should be decided in an *inter partes* proceeding. The Court of Appeals apparently preferred not to make a ruling on this question of the scope of R. S. 4915. From the *per curiam* opinion it is plain that the Court of Appeals did not wish to be understood as deciding in an *ex parte* R. S. 4915 action the question of patentability as between two former litigants and that they were therefore deciding the case *on other grounds*, namely, patentability over the prior art.

No other construction can be placed on the *per curiam* decision of the Court of Appeals of the District of Columbia, and there is no support whatsoever for the expressed belief of the solicitor for the Patent Office that the Court of Appeals^{es} for the District of Columbia meant

merely the Jenkins patent when it said the claims were "unpatentable over the prior art."

The Solicitor for the Patent Office calls attention (p. 7 of his Brief) to the citation by the Court of Appeals in its *per curiam* opinion, of the following decisions:

Daniels v. Coe, 116 F. (2d) 941, 945;
Abbott v. Coe, 109 F. (2d) 449, 451-452;
Morrison v. Coe, 127 F. (2d) 737, 738.

He deduces from the citation of these cases that the Court must have meant by the expression "unpatentable over the prior art", unpatentable over *the Jenkins patent*. His stated reason for this deduction is that in *one* of these cases (*Daniels v. Coe*) the plaintiff had been in a Patent Office interference and one of the grounds of rejection was patentability of the presented claims in view of the award to his adversary. It is noted that in *Daniels v. Coe* the Court decided that the claims presented were unpatentable over the interference counts constituting the claims of the patent granted the former interfering party, *but in no instance is that patent referred to as "prior art"*.

The Court of Appeals obviously cited these *three* cases because of the ruling common to all *three* cases, namely, that an appellant from an adverse decision in a R. S. 4915 action must convince the Court of Appeals that the lower Court and the Patent Office were "clearly wrong" in their conclusions that the patent should be refused. From this established rule, which deals only with the *weight* to be given the decisions of the lower tribunals, the Court of Appeals reasoned that it can affirm the judgment of the lower Court without deciding the issues presented if for *any reason* it was of the opinion that the patent should not be granted.

It is Petitioner's contention that such practice is contrary to the established procedure of this Court and results in a final ruling adverse to the applicant on the claims sought to be patented *without any review* of the decision so made, and without any opportunity for the applicant to present, by brief and argument, his reasons why the grounds on which his patent is finally refused by the Court of Appeals are unsound.

On pages 8 and 9 of his brief, the solicitor for the Patent Office attempts by a short quotation from its own brief before the Court of Appeals, to make it appear that the difference between the Herthel and Jenkins processes lies merely in the fact that in the Herthel process the oil is circulated fast enough to prevent an accumulation of sediment in the tubes. This is not the fact. In *both* the *Herthel* and *Jenkins* processes the circulation of oil is fast enough to prevent the accumulation of sediment in the tubes. The difference lies elsewhere, but Petitioner will not undertake to explain either process within the confines of a brief in support of a petition for certiorari. The question presented by this petition is solely whether or not the applicant is entitled to a review of the question decided by the lower Court in this case, or must he accept as final the refusal of his claims *on other grounds* without the opportunity to contest that refusal and offer evidence to establish that the reasons for such refusal are unsound. Until the right of review is granted, any discussion of the nature of the invention, etc. is premature.

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New York, N. Y.,
Sept. 19, 1944.